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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,594	10/17/2001	Jean-Francois Biegun	CAC.P0022	8151

7590 05/21/2003

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EXAMINER

LANDREM, KAMRIN R

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 05/21/2003 4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/981,594

Applicant(s)

BIEGUN ET AL.

Examiner

Kamrin R. Landrem

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Drawings

The drawings are objected to because the perpendicular projections recited in the claims are not depicted in the figures. It is recommended that applicant include notation to indicate perpendicular lines (right angles) in the drawings. The reference numeral 15 indicates one edge in Fig. 3 and a different edge (16) in Fig. 4. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities: The applicant's specification uses the terms "projection" and "trajectory" interchangeably to describe reference numeral (4) (see Figs. 4 and 5). It is recommended that applicant use consistent terminology when referring to reference numeral (4).

The meaning of the term "fragilize", pg. 4, line 20, is not clear.

Appropriate correction is required.

Claim Objections

Claims 6 and 7 are objected to because of the following informalities:

Claim 6 and 7 are objected to because of the inconsistent terminology "slant angle" and "tilt angle". It is recommended that applicant amend claim 6 to recite -- tilt angle --.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "at least one, but preferably two condyles". It is recommended that applicant amend the claim to recite -- at least one condyle--.

Claim 4 is indefinite because it is unclear what applicant is referring to when reciting "femur's external rotation method such that said method is no longer necessary". The specification and claims contain no additional support for the claimed external rotation method. Clarification is requested.

Claim 5 recites a broad range followed with a narrow range.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of

the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 5 recites the broad recitation “one and ten degrees”, and the claim also recites “two and five degrees” which is the narrower statement of the range/limitation.

For examination purposes the examiner interprets this limitation in the broadest terms, i.e. between one and ten degrees.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims ¹⁻¹²~~1-3 and 5-12~~ are rejected under 35 U.S.C. 102(b) as being anticipated by Hollister (USPN 5,326,361).

Claim 1, with regards to a femoral component (20) having a trochlean part (23) and at least one condyle (21,22), see Figs. 5 and 6. With regards to trochlean trajectory it is anticipated that applicant is referring to the area of travel along the curved path of the trochlean groove (23), see SP in Fig. 3. The set of internal flat sides (20a,b,c,d,e) is anticipated by Hollister, see Figs. 5 and 6. With regards to a reference line (TP) in the horizontal perspective and the perpendicular projection of the trochlean trajectory (SP), see Figs. 3 and 9. The tilt angle is anticipated by β of Figs. 9 and 10. The angle value of β is different than absolute zero when orthogonally projected

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within the medial lateral perspective. Hollister discloses that this angle can have a value between 3 and 7 degrees, see col. 8, lines 24-27.

Claim 2, with regards to an internal open cage has five flat sides, see (20a,b,c,d,e) in Fig. 5.

Claim 3, with regards to the spherical shape of condyles, see Figs. 5 and 6.

Claim 4, with regards to tilt angle and its relation to the femur's external rotation, see col. 8, lines 24-29.

Claim 5, with regards to tilt angle, see col. 8, lines 24-27.

Claim 6, with regards to a couple of femoral components having respective tilt angles that have opposite trigonometric sides, Hollister discloses a left femoral component, however it is anticipated that a right femoral component would have the appropriate angle (opposite that of the left knee) to align with the body's mechanical axis. See col. 8, line 62-65

Claim 7, with regards to respective tilt angles having the same absolute value; it is inherent that both right and left femoral components would possess similar tilt angles. See col. 8, lines 24-27 and lines 62-65.

Claims 8-12, with regards to tibial component (24), see Fig. 5.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following US Patents contain information relevant to applicant's invention, 5,133,758; 6,458,160; 6,540,787; 6,210,443.

Art Unit: 3738


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamrin R. Landrem whose telephone number is 703-305-8061. The examiner can normally be reached on 8:00-5:00, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 703-308-2111. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-3905 for regular communications and 703-308-3905 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

Kamrin Landrem
Examiner
AU 3738

KRL
May 15, 2003


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